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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,640	05/13/2008	Gregor Esser	100341.58126US	3282

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EXAMINER
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COLLINS, DARRYL J

ART UNIT	PAPER NUMBER
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2873

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,640	<b>Applicant(s)</b> ESSER ET AL.	
	<b>Examiner</b> DARRYL J. COLLINS	<b>Art Unit</b> 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14, 16, 17, 20-23, 25 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 16, 17, 20-23, 25 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 14 and 23 have been considered but are moot in view of the new ground(s) of rejection.

Although the arguments, filed May 9, 2011, are moot in view of the new rejections below, the examiner would like to address the arguments.

With respect to Applicant's arguments that Hoya fails to provide teachings that demonstrate a preference or advantage in separating the viewing region from the carrier rim region by a dividing curve (page 9, third paragraph, lines 3-5), it should be noted that Hoya, as outlined in the rejection of claims 14 and 23, meet all of the claimed structural limitations of the instant invention and the preference or advantage in separating the viewing region from the carrier rim region by a dividing curve does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d - 164 7 (1987).

With respect to Applicant's arguments that Hoya fails to teach or suggest "the carrier rim region extends from the dividing curve radially as far a peripheral curve matching a rim of the spectacle lens in an encased state" (page 8, second paragraph), the examiner respectfully disagrees. Hoya teaches the V-shaped portion and a lens portion in an outer circumference of a spectacle lens for insertion into a spectacle lens (page 1, second paragraph) such that the carrier rim region would extend from the dividing curve radially to the periphery of the lens matching

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the rime of the spectacle lens in an *encased state {emphasis added}*, i.e. once encased, the lens curve matches the spectacle rim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 16, 17, 21-23, 25 and 28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoya (JP 61023106).

With regard to independent claim 14, Hoya teaches a spectacle lens (page 1 and Figure 2, element 1) having object-sided front face (Figure 1, element 3) and an eye-sided (Figure 1, element 2) rear face (Figure 1), wherein the rear face (Figure 1, element 2) comprises a viewing region (pages 1-2) disposed thereon which contributes to the optical effect of the spectacle lens, and wherein the rear face further comprises a carrier rim region (Figure 2, element 5) also disposed thereon which surrounds at least partially the viewing region and which does not significantly contribute to the optical effect of the spectacle lens (pages 1-3), wherein the rear face in the carrier rim region is constructed substantially based on desired cosmetic properties, without consideration of optical image-forming properties (pages 1-4, wherein the chamfered portion is formed to a shape for insertion into a frame for better comfort and look for the user), wherein the viewing region is separated from the carrier rim region (Figure 1, element 5) on the rear face of the spectacle lens by a dividing curve (Figure 1, element 6) that connects penetrating

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points of outermost peripheral rays to the rear face, said outermost peripheral rays just barely passing, under direct vision, through a point of rotation of the eye when the spectacle lens is in a use position in front of an eye (pages 1-2 and 5, wherein the line 6 defines the separation between the vision section and the chamfered portion, which is placed in a frame and therefore the outermost visible rays are inherently along the line before the frame), wherein the carrier rim region extends from the dividing curve radially as far a peripheral curve matching a rim of the spectacle lens in an encased state (page 1, second paragraph) and wherein further the rear face in the carrier rim region is constructed to consider: at least one of a frame shape and a frame design; and individual parameters of the spectacle wearer (pages 1-2, wherein the chamfered region is formed for particular user lens frames).

It should also be noted, as evidenced by Dillon (U.S. Patent Number 3,063,340), that it is old and well-known in the ophthalmic art to have a spectacle lens wherein the carrier rim region extends to the peripheral of the lens such that the peripheral curve matches the rim of the spectacle lens in an encased state (column 1, lines 9-18) such that it would have been obvious to one of ordinary skill in the art at then time the invention was made to modify the spectacle lens, as taught by Hoya, with the well-known technique of contouring the spectacle lens to conceal the edge when mounted, i.e., encased.

With regard to independent claim 16, Hoya teaches a spectacle lens (page 1 and Figure 2, element 1) having object-sided front face (Figure 1, element 3) and an eye-sided (Figure 1, element 2) rear face (Figure 1), wherein the rear face (Figure 1, element 2) comprises a viewing region (pages 1-2) disposed thereon which contributes to the optical effect of the spectacle lens, and wherein the rear face further comprises a carrier rim region (Figure 2, element 5) also

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disposed thereon which surrounds at least partially the viewing region and which does not significantly contribute to the optical effect of the spectacle lens (pages 1-3), wherein the rear face in the carrier rim region is constructed substantially based on desired cosmetic properties, without consideration of optical image-forming properties (pages 1-4, wherein the chamfered portion is formed to a shape for insertion into a frame for better comfort and look for the user), wherein the viewing region is separated from the carrier rim region (Figure 1, element 5) on the rear face of the spectacle lens by a dividing curve (Figure 1, element 6) that connects the penetrating points of outermost peripheral rays to the rear face, and said outermost peripheral rays just barely pass, under indirect vision, through the center of the entrance pupil of the eye, (pages 1-2 and 5, wherein the line 6 defines the separation between the vision section and the chamfered portion, which is placed in a frame and therefore the outermost visible rays are inherently along the line before the frame), wherein the carrier rim region extends from the dividing curve radially as far a peripheral curve matching a rim of the spectacle lens in an encased state (page 1, second paragraph) and wherein further the rear face in the carrier rim region is constructed to consider: at least one of a frame shape and a frame design; and individual parameters of the spectacle wearer (pages 1-2, wherein the chamfered region is formed for particular user lens frames).

It should also be noted, as evidenced by Dillon (U.S. Patent Number 3,063,340), that it is old and well-known in the ophthalmic art to have a spectacle lens wherein the carrier rim region extends to the peripheral of the lens such that the peripheral curve matches the rim of the spectacle lens in an encased state (column 1, lines 9-18) such that it would have been obvious to one of ordinary skill in the art at then time the invention was made to modify the spectacle lens,

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at taught by Hoya, with the well-known technique of contouring the spectacle lens to conceal the edge when mounted, i.e., encased.

With regard to dependent claim 17, Hoya teaches all of the claimed limitations of the instant invention as outlined above with respect to independent claim 14 and further teaches the spectacle lens exhibiting at least one of a positive, negative, progressive, astigmatic and prismatic optical power (Figure 1, the lens inherently exhibits negative power based on the shape of the lens).

With regard to dependent claim 20, Hoya teaches all of the claimed limitations of the instant invention as outlined above with respect to independent claim 14 and further teaches the rear face being designed so that the rear face of the carrier rim region is joined in a at least once, preferably in a twice continuously, differentiable manner to the rear face in the viewing region (Figure 1, wherein the lens comprises a continuous rear surface, pages 2-3).

With regard to dependent claim 21, Hoya teaches all of the claimed limitations of the instant invention as outlined above with respect to independent claim 14 and further teaches the rear face in the carrier rim region to be constructed to reduce at least one of an edge thickness, edge thickness variation and center thickness of the spectacle lens (pages 1 and 5).

With regard to dependent claim 22, Hoya teaches all of the claimed limitations of the instant invention as outlined above with respect to independent claim 14 and further teaches the rear face in the carrier rim region to be configured to reduce volume and mass of the entire spectacle lens (pages 1 and 5).

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With regard to independent claim 23, Hoya teaches a method for producing a spectacle lens (page 1 and Figure 1, element 1) with an object-sided front face (Figure 1, element 3) and an eye-sided (Figure 1, element 2) rear face (Figure 1), wherein the spectacle lens comprises a viewing region (pages 1-2) on the rear face that contributes to the optical effect of the spectacle lens, and wherein the spectacle lens further comprises a carrier rim region (Figure 2, element 5) that is also on the rear face and that at least partially surrounds the viewing region and does not significantly contribute to the optical effect of the spectacle lens, comprising carrying out at least one of a calculation and optimization of the rear face in the carrier rim region carried out essentially based on desired cosmetic properties, without considering the optical image-forming properties of the carrier rim region (pages 1-4, wherein the chamfered portion is formed to a shape for insertion into a frame for better comfort and look for the user), wherein the at least one of calculation and optimization comprises calculation of a dividing curve (Figure 1, element 6) on the rear face between the viewing region and the carrier rim region (Figure 2, element 5) in a curve shape that connects penetrating points of outermost peripheral rays to the rear face, said outermost peripheral rays just barely passing, under direct vision, through a point of rotation of the eye when the spectacle lens is in a use position in front of the eye of a spectacle wearer (pages 1-2 and 5, wherein the line 6 defines the separation between the vision section and the chamfered portion, which is placed in a frame and therefore the outermost visible rays are inherently along the line before the frame), wherein the carrier rim region extends from the dividing curve radially as far as a peripheral curve matching a rim of the spectacle lens in an encased state (page 1, second paragraph) and wherein further the rear face in the carrier rim region is constructed to consider: at least one of a frame shape and a frame design; and

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individual parameters of the spectacle wearer (pages 1-2, wherein the chamfered region is formed for particular user lens frames).

It should also be noted, as evidenced by Dillon (U.S. Patent Number 3,063,340), that it is old and well-known in the ophthalmic art to have a spectacle lens wherein the carrier rim region extends to the peripheral of the lens such that the peripheral curve matches the rim of the spectacle lens in an encased state (column 1, lines 9-18) such that it would have been obvious to one of ordinary skill in the art at then time the invention was made to modify the spectacle lens, as taught by Hoya, with the well-known technique of contouring the spectacle lens to conceal the edge when mounted, i.e., encased.

With regard to independent claim 25, Hoya teaches a spectacle lens (page 1 and Figure 2, element 1) having object-sided front face (Figure 1, element 3) and an eye-sided (Figure 1, element 2) rear face (Figure 1), wherein the rear face (Figure 1, element 2) comprises a viewing region (pages 1-2) disposed thereon which contributes to the optical effect of the spectacle lens, and wherein the rear face further comprises a carrier rim region (Figure 2, element 5) also disposed thereon which surrounds at least partially the viewing region and which does not significantly contribute to the optical effect of the spectacle lens (pages 1-3), wherein the rear face in the carrier rim region is constructed substantially based on desired cosmetic properties, without consideration of optical image-forming properties (pages 1-4, wherein the chamfered portion is formed to a shape for insertion into a frame for better comfort and look for the user), wherein the viewing region is separated from the carrier rim region (Figure 1, element 5) on the rear face of the spectacle lens by a dividing curve (Figure 1, element 6) that connects the penetrating points of outermost peripheral rays to the rear face, and said outermost peripheral

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rays just barely pass, under indirect vision, through the center of the entrance pupil of the eye, (pages 1-2 and 5, wherein the line 6 defines the separation between the vision section and the chamfered portion, which is placed in a frame and therefore the outermost visible rays are inherently along the line before the frame), wherein the carrier rim region extends from the dividing curve radially as far a peripheral curve matching a rim of the spectacle lens in an encased state (page 1, second paragraph) and wherein further the rear face in the carrier rim region is constructed to consider: at least one of a frame shape and a frame design; and individual parameters of the spectacle wearer (pages 1-2, wherein the chamfered region is formed for particular user lens frames).

It should also be noted, as evidenced by Dillon (U.S. Patent Number 3,063,340), that it is old and well-known in the ophthalmic art to have a spectacle lens wherein the carrier rim region extends to the peripheral of the lens such that the peripheral curve matches the rim of the spectacle lens in an encased state (column 1, lines 9-18) such that it would have been obvious to one of ordinary skill in the art at then time the invention was made to modify the spectacle lens, as taught by Hoya, with the well-known technique of contouring the spectacle lens to conceal the edge when mounted, i.e., encased.

With regard to dependent claim 28, Hoya teaches all of the claimed limitations of the instant invention as outlined above with respect to independent claim 23 and further teaches the rear face being designed so that the rear face of the carrier rim region is joined in a at least once, preferably in a twice continuously, differentiable manner to the rear face in the viewing region (Figure 1, wherein the lens comprises a continuous rear surface, pages 2-3).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARRYL J. COLLINS whose telephone number is (571)272-2325. The examiner can normally be reached on 6:30 - 5:00 Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Darryl J. Collins/  
Primary Examiner  
Art Unit 2873

09 June 2011